

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

SAMSUNG ELECTRONICS AMERICA, INC., and  
SAMSUNG ELECTRONICS CO., LTD.,  
Petitioner,

v.

SMARTFLASH LLC,  
Patent Owner.

---

Case CBM2015-00059  
Patent 8,336,772

---

**REPLY TO PATENT OWNER'S OPPOSITION  
TO MOTION FOR JOINDER**

**I. Introduction**

In “Patent Owner’s Opposition to Petitioner’s Motion for Joinder Under 35 U.S.C. § 325(c) and 37 C.F.R. § 42.222(b) or, in the Alternative, for Coordination of Schedule, and Request for Shortened Response Time for Patent Owner’s Preliminary Response” (“Opposition”), Patent Owner advances various positions that are either unfounded in or contrary to the Board’s precedent. Therefore, Patent Owner’s Opposition provides no basis for denying Petitioner’s Motion for Joinder.

**II. Petitioner Has Not Challenged Any Claims of the ’772 Patent Under 35 U.S.C. § 101 in CBM2014-00204**

Patent Owner incorrectly asserts that “Petitioner already raised the issue of unpatentability under § 101.” Opposition, p. 4. In support of this assertion, Patent Owner cites to a table included in the Petition and Corrected Petition in CBM2014-00204, and to a listing of grounds in the Board’s Patent Review Processing System (PRPS). *Id.* These references to § 101 are clearly clerical errors, and, as they constitute the only Petition references to § 101, the context provided by the Petition reveals that these do not themselves amount to a § 101 challenge, as Patent Owner has led the Board believe.

Indeed, as Patent Owner itself notes, the Petition in CBM2014-00204 did not include “any evidence to support” a ground of unpatentability under 35 U.S.C. § 101. *See id.* Outside of being listed in a table on page 3, neither the Petitioner

nor the Corrected Petition make any other mention of a challenge under § 101.

When facing similar circumstances, the Board has dismissed clerical errors in a Petition's identification of grounds of unpatentability where, as here, the circumstances make the error unquestionably clear and the Board is notified of the error. *See, e.g., ACCO Brands Corp. v. Fellowes, Inc.*, IPR2013-00566, Paper No. 37, p. 3 (P.T.A.B. Feb. 12, 2015) (holding a claim should “not [be] regarded as a challenged claim in this *inter partes* review proceeding” where Petitioner notified the Board of the claim's mistaken mention in the petition). Accordingly, the Board should now dismiss Patent Owner's contention that Petitioner challenged any claims of the '772 Patent under 35 U.S.C. § 101 in CBM2014-00204.

Notably, this is the only argument Patent Owner raises regarding Petitioner's satisfaction of the factors of joinder set out in *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (Apr. 24, 2013). As this argument has been proven moot, the *Kyocera* factors should be considered met.

**III. The Schedule of this Proceeding Should Be Altered, Not the Schedule of CBM2014-00200 or -00204**

Patent Owner argues that a “scheduling order should be set such that the schedule of the granted Petition in CBM2014-00200 and/or -00204 be coordinated with this case, rather than the other way around.” Opposition, pp. 4-5. However, Patent Owner cites no Board precedent to support its proposal, nor does Patent Owner provide any reason why such a scheduling change should be made in either

of CBM2014-00200 or -00204. Rather, Patent Owner simply notes that “the schedule in CBM2014-00200 and -00204 would at most be extended about two months -- still within the additional 6 months that can be granted by the Chief Administrative Patent Judge for good cause under 42.300(c).” Opposition, p. 5.

As Patent Owner correctly identifies, the extraordinary measure of extending a covered business method review beyond its statutorily preferred completion deadline of one year from institution requires the Board to identify “good cause.” 35 U.S.C. § 326(a)(11); 37 C.F.R. § 42.300(c). However, Patent Owner makes no attempt to argue that there exists good cause to extend the schedule of either CBM2014-00200 or -00204. *See* Opposition, pp. 4-5. As no such good cause exists, the Board should dismiss Patent Owner’s request.

**IV. Even If the Time Period for Patent Owner’s Preliminary Response Is Not Altered, Joinder Should Still be Granted**

In its Motion for Joinder, Petitioner requested that the Board specify a shortened response period of February 12<sup>th</sup> or 26<sup>th</sup> for Patent Owner’s Preliminary Response. Motion for Joinder, p. 2. As these dates have passed, Petitioner renews its request that the Board specify a shortened preliminary response period.

The current deadline by which Patent Owner must file its preliminary response is May 10, 2015, which is more time than should be required for Patent Owner to prepare a preliminary response. As Petitioner previously noted in its Motion for Joinder and Patent Owner admitted in its Opposition, Patent Owner has

CBM2015-00059  
Patent 8,336,772

already considered a challenge to claims of the '772 Patent under § 101 in each of CBM2015-00031, -00032, and -00033, which were filed by Apple, Inc. *See* Motion for Joinder, p. 4; *see also* Opposition, p. 1 (admitting this fact). Indeed, Patent Owner already filed its preliminary patent owner response in CBM2015-00031, -00032, and -00033 on March 6, 2015. *See* CBM2015-00031, Paper 8; CBM2015-00032, Paper 8; CBM2015-00033, Paper 8. Therefore, Patent Owner cannot legitimately proclaim prejudice by a shortened period in which to respond to a purely legal issue to which Patent Owner already responded in a co-pending proceeding.

In CBM2014-00200 and -00204, Patent Owner filed its preliminary responses on January 6, 2015 and the Board's subsequent institution decisions and scheduling orders will, thus, be due no later than April 6, 2015, pursuant to 35 U.S.C. § 324(c). Accordingly, Petitioner proposes a teleconference between Petitioner, Patent Owner, and the Board to discuss a reasonable shortened deadline for the preliminary response or, alternatively, whether the preliminary response should be waived altogether in light of Patent Owner having already responded to similar issues in its preliminary responses in CBM2015-00031, -00032, and -00033.

However, even if the Board does not shorten the time period for Patent Owner's preliminary response in this proceeding, the Board should still grant

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.